

REMARKS

Claims 1-14 and 26-30 are currently pending in the application. By this amendment, claims 29 and 30 are added for the Examiner's consideration. The new claims do not add new matter to the application and are fully supported by the original disclosure. For example, support for the new claims is provided in the claims as originally filed, at Figures 2, and at pages 6-8 of the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Complete Action Requested

Applicants note that throughout prosecution of the instant application, the Examiner has failed to provide any explanation as to how or why many of the dependent claims are considered to be unpatentable over the applied art. Instead, the Examiner has repeatedly grouped all pending claims together under the heading of a single rejection and explained a rejection of the independent claim, without addressing the features of many of the dependent claims. Moreover, the Examiner has failed to answer the substance of Applicants' arguments when this was pointed out to the Examiner.

For example, at least claims 4, 5, 8, 9 and 14 were not addressed in the Office Action dated March 14, 2008. That is to say, the Examiner listed these claims as rejected, but provided no explanation of the rejection regarding the features recited in these claims. Applicants pointed out this omission and made arguments regarding the merits of these claims in the Amendment dated June 16, 2008. Subsequently, in the pending Office Action dated September 23, 2008, the Examiner addressed claims 8 and 9; however, the Examiner again failed to address the features recited in claims 4, 5, and 14, and did not answer Applicants' argument regarding claims 4, 5, and 14. Moreover, in the pending Office Action dated September 23, 2008, the Examiner failed to address the features recited in claims 26-28, which were newly added in the Amendment dated June 16, 2008.

Applicants direct the Examiner's attention to 35 U.S.C. 132(a), which states:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and

references as may be useful in judging of the propriety of continuing the prosecution of his application

[emphasis added].

Also, MPEP 2141 states:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.

[emphasis added].

Additionally, MPEP 2143.01 states: “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Also, 37 C.F.R. 1.104(a)(1) states that “[t]he examination shall be complete with respect ... to the patentability of the invention as claimed” Moreover, MPEP §707.07(d), states that “[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” Even further, MPEP 707.07(f) requires that

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

...

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Accordingly, Applicants respectfully request that the Examiner consider each pending claim individually, and provide an explanation of the patentability determination of each pending claim. In other words, Applicants respectfully request that the Examiner provide a complete action by providing a clear explanation of every rejection made, and by taking note of and answering the substance of all of Applicants' arguments.

Provisional Double Patenting Rejection

Claims 1-14 and 26-28 are provisionally rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/932,337.

Applicants initially note that this same rejection was previously withdrawn by the Examiner in the Office Action dated March 14, 3008. However, in the instant Office Action, the Examiner reinstates this rejection, without any explanation of why it was first withdrawn and then made again. Applicants submit that such examination procedures do not comport with the principles of compact prosecution.

In any event, Applicants submit that this is a *provisional* double patenting rejection. Accordingly, Applicants are not providing a terminal disclaimer at this time. If the present application issues prior to the '337 application, the provisional nonstatutory obviousness-type double patenting rejection should be withdrawn and made in the copending application (see MPEP §804). If, however, the '337 application issues prior to the present application, the Examiner may make this rejection a non-provisional nonstatutory obviousness-type patenting, and Applicants will, at such time, traverse such rejection or file a terminal disclaimer, whichever is appropriate.

However, in order to be fully responsive, Applicants provide the following traversal of the double patenting rejection. First, Applicants submit that the double patenting rejection is procedurally improper because the Examiner fails to make clear the differences between the inventions defined by the conflicting claims, as required by MPEP §804. The explanation includes no comparison of the claims in the '337 application and the claims of the instant

application. The Examiner's contention that it would have been obvious to rearrange parts does not serve to adequately address and compare the features recited in the claims, as required by MPEP §804. Therefore, the rejection is improper on its face, and should be withdrawn for this reason alone.

Second, Applicants submit that claims 1-14 and 26-28 of the present invention recite features that are not recited in claims 1-10 of the '337 application. For example, claim 5 of the instant application recites the board is ground; however, this is not recited in any of claims 1-10 of the '337 application. Additionally, claims 8 and 9 of the instant application recite mixing/scattering at least one of antibacterial and antistatic additives; however, antibacterial and antistatic additives are not recited in any of claims 1-10 of the '337 application. Also, claim 11 of the instant application recites providing a filler comprising wood fiber, wood dust, metals, mineral substances, plastics, or ash; however, such a filler is not recited in any of claims 1-10 of the '337 application. Moreover, claim 26 of the instant application recites sawing the board centrally along the at least one V joint to create panels each having a chamfered edge; however, none of claims 1-10 of the '337 application teaches sawing. Therefore, the double patenting rejection is improper because at least claims 5, 8, 9, 11, and 26 of the instant application recite features that are not recited or suggested by claims 1-10 of the '337 application.

Furthermore, Applicants note that the Examiner has failed to address the arguments that (i) the rejection is procedurally improper and (ii) that the claims of the instant application recite features that are not recited in claims 1-10 of the '337 application. Applicants made these same arguments in a response dated August 27, 2007 and again in another response dated February 8, 2008. Should the Examiner repeat the rejection in the next Office Action, Applicants respectfully request that the Examiner take note of these separate arguments and answer the substance of them.

Accordingly, for all of the above-noted reasons, Applicants respectfully request that the provisional double patenting rejection over claims 1-14 and 26-28 be withdrawn.

35 U.S.C. §103 Rejection

Claims 1-14 and 26-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,137,229 issued to Pervan ("Pervan"). This rejection is respectfully traversed.

It is well established that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness (see, e.g., MPEP §2142). To establish a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974); see also, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). If the prior art reference(s) do not teach or suggest all of the claim limitations, Office personnel must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art (MPEP 2141).

Claim 1

The invention relates to a process for finishing a wooden board that can be used, for example, for furniture construction and flooring panels. The process of manufacturing the flooring panels includes providing a printing on the protective layer of melamine resin, which avoids the use of a paper layer and ensures that the printing will not impregnate the board. As discussed at page 7 of Applicants' application, this provides benefits over systems that use paper layers:

The fact that the decoration is printed onto the board means that not only are the problems associated with the paper growth avoided but also the handling associated with laying the paper web on the upper side of the board. As a result of applying the sealing layer to the substrate board, the printing ink is prevented from being absorbed by the substrate board, which would be the case without the sealing layer, since the substrate board as such is absorbent.

In particular, independent claim 1 recites:

1. Process for finishing a wood or wooden board, in particular an MDF or HDF board with an upper side and an underside, comprising the following steps:

- a) applying a sealing layer of melamine resin to the upper side of the board,
- b) printing a decoration onto the sealing layer,
- c) applying a protective layer of melamine resin to the decoration, and
- d) pressing the board under the action of temperature until the protective layer and the sealing layer melt and bond to each other with the inclusion of the decoration printed thereon.

In the pending Office Action, the Examiner refers to the comments made in the previous Office Action dated March 14, 2008, in which the Examiner generally asserts that Pervan

discloses the features of claim 1 at lines 20-52 of col. 2, lines 20-30 of col. 3, lines 16-22 of col. 6, and the claims. However, Applicants submit that Pervan does not disclose the recited method steps of: (a) *applying a sealing layer of melamine resin to the upper side of the board* and (b) *printing a decoration onto the sealing layer*.

Instead, Pervan uses a decorative paper layer and a much different process. As is well understood in the art, in the process described by Pervan, a decoration is printed on a paper layer 35, the paper layer 35 is then soaked in melamine, after which the melamine-impregnated paper layer 35 is applied to the core 30. These layers combine to form surface layer 31 upon pressing under heat. See, e.g., lines 1-19 of col. 7, and FIGS. 2a-2e. This process does not constitute printing a decoration onto a melamine sealing layer, as recited in the claimed invention. Instead, the Pervan process comprises printing the decoration onto paper and then later applying the paper to the board, which is clearly different from applying a melamine sealing layer to the board and then printing onto the sealing layer.

Applicants also acknowledge, as the Examiner correctly notes, that Pervan discloses a different method in the Background section. Specifically, Pervan states: "A decorative pattern can be printed on the surface of the core, which is then, for example, coated with a wear layer" (col. 2, lines 48-50). However, in this alternative method, Pervan makes no mention whatsoever of applying a sealing layer to the core, and then printing a decoration onto the melamine sealing layer. Instead, Pervan omits the sealing layer, and discloses printing on the core. Because the alternative method does not use a sealing layer between the board and printing ink, it is arguably impossible for this alternative method to be construed as teaching (a) *applying a sealing layer of melamine resin to the upper side of the board* and (b) *printing a decoration onto the sealing layer*, as recited in claim 1.

The Examiner, however, maintains the position that "it would have been obvious to print a decorative matter on the coated core or include the printed matter in the layer that is applied to the core" As to the first part of this assertion (i.e., it would have been obvious to print a decorative matter on the coated core), Pervan does not disclose an intermediate "coated core." The only "coated core" arguably disclosed by Pervan is the finished product (i.e., FIG. 2c or FIG. 2e). Therefore, such a modification would result in printing on the outer surface of wear layer 34, and there would not be an additional layer applied over the decoration. Such a modification, however, excludes step (c), i.e., *applying a protective layer of melamine resin to*

the decoration, and therefore would not result in the combination of method steps recited in claim 1.

As to the second part of the assertion (i.e., it would have been obvious to include the printed matter in the layer that is applied to the core), this modification would not result in the claimed combination. That is to say, including printing matter in a layer applied to the core does not constitute *printing a decoration on a sealing layer that is already applied to the core*.

Furthermore, Applicants submit that the Examiner's assertion that "it would have been obvious to print a decorative matter on the coated core or include the printed matter in the layer that is applied to the core" is factually unsupported by the evidence of the record, and amounts to speculation in an attempt to conform the applied art to Applicants' claimed invention. The Examiner is reminded that rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Office may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. *See, In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

For these reasons, Applicants submit that Pervan fails to disclose or suggest all of the features of independent claim 1. Therefore, Pervan does not anticipate or render obvious the invention recited in claim 1. Claims 2-14 and 26-28 depend from claim 1 and are distinguishable from Pervan at least for the reasons discussed above with respect to claim 1. Moreover, Pervan fails to disclose or suggest many of the additional features recited in these dependent claims.

Claim 4

Claim 4 depends from claim 1, and additionally recites *a plurality of individual layers are applied for at least one of the sealing layer and the protective layer and each individual layer dries out before the application of the next*. As argued in Applicants' previous response, and as discussed during the personal interview conducted on May 1, 2008, Pervan does not disclose or suggest applying a plurality of sealing or protective layers, much less allowing each individual layer to dry before application of the next layer.

Moreover, as noted in the previous response dated June 16, 2008, the Examiner fails to address the language of claim 4 in the rejection. Instead, the Examiner has improperly grouped claim 4 with the rejection of other claims while failing to address the language of claim 4.

Claim 5

Claim 5 depends indirectly from claim 1, and additionally recites *the board is ground before the sealing layer is applied*. Pervan does not disclose or suggest grinding the core before applying a sealing layer. In fact, this would not even be contemplated by Pervan as this would prevent the paper layer from being applied in a smooth manner, which would destroy the aesthetics of the panel, itself.

Claims 8 and 9

Claims 8 and 9 depend indirectly from claim 1, and additionally recite mixing/scattering *at least one of antibacterial and antistatic additives* into/onto a layer of the protective layer. Pervan does not disclose or suggest antibacterial and antistatic additives.

The Examiner asserts that "covering the whole board including sides with melamine and adding corundum or antibacterial and antistatic additives into or onto layer (*sic*) is routine in the art." Applicants note that this statement amounts to a reliance on Official Notice with respect to claims 8 and 9. MPEP 2144.03 provides the following guidance regarding Official Notice:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

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If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

Applicants submit that mixing/scattering antibacterial and/or antistatic additives into/onto a protective layer of melamine resin that has been applied to a decoration printed on a sealing layer is not common knowledge that is capable of instant and unquestionable demonstration as being well-known. Therefore, Applicants respectfully traverse this taking of Official Notice, and request the Examiner provide documentary evidence to support this position.

Claim 14

Claim 14 depends from claim 1, and additionally recites *a structure or at least one V joint is impressed into the protective layer*. Pervan does not disclose or suggest impressing a V joint into the protective layer. Pervan admittedly does disclose bevels 80, 81 formed in the core 30 (FIG. 6c). However, the bevels 80, 81 are formed in the core 30 before lamination. Therefore, the bevels 80, 81 do not constitute *a structure or at least one V joint is impressed into the protective layer*.

Claim 26

Claim 26 depends from claim 14, and additionally recites *sawing the board centrally along the at least one V joint to create panels each having a chamfered edge*. Pervan does not disclose sawing a board centrally along a V joint that has been pressed in a protective layer. Nor has the Examiner even addressed this feature in the rejection.

Claim 27

Claim 27 depends from claim 1, and additionally recites *the applying the sealing layer and the printing are devoid of paper layers*. In contrast to claim 27, Pervan clearly shows using a decorative paper layer 35 to provide the printed decoration on the core 30. Moreover, Applicants note the Examiner has not addressed claim 27 in the explanation of the rejection.

Claim 28

Claim 28 depends from claim 1, and additionally recites *the printing a decoration onto the sealing layer prevents impregnation of the printing onto the board*. In contrast to claim 28, Pervan discloses applying stained impregnating material 24 to the core surface of board in the area of the joints prior to applying a decorative paper layer which is impregnated with melamine. Therefore, Pervan explicitly discloses impregnation of the board.

For all of the above reasons, Applicants submit that claims 1-14 and 26-28 are distinguishable from Pervan. Accordingly, Applicants respectfully request that the §103 rejection of claims 1-14 and 26-28 be withdrawn.

New Claims

Claims 29 and 30 are added by this amendment. New claims 29 and 30 depend from claim 1, and are distinguishable from the applied art at least for the reasons discussed above with respect to claim 1. Moreover, these claims recite combinations of features that are not disclosed or suggest by the applied art.

CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
Frank OLDORFF

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', is written over a horizontal line.

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